



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,542	01/29/2001	Hideo Okano	01045\LH	9601
1933	7590	11/24/2003	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023			JACKSON, JAKIEDA R	
		ART UNIT	PAPER NUMBER	
		2655		

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/771,542	OKANO, HIDEO
	Examiner	Art Unit
	Jakieda R Jackson	2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is **FINAL**.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-9 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-9 is/are rejected.  
 7) Claim(s) 9 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 29 January 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 01/31/2000. It is noted, however, that applicant has not filed a certified copy of the 2000-022752 application as required by 35 U.S.C. 119(b).

### *Specification*

2. The specification is objected to because of the following informalities:
  - The words "as", page 7, lines 14 and 19 should be --is--.  
Appropriate correction is required.
  - All items followed by " and the like", should be "or the like". For example, page 9, line 21  
Appropriate correction is required

### *Claim Objections*

3. **Claim 9** is objected to because of the following informalities:
  - In regards to **claim 9**, the word "mean" line 1 should be --means--.  
Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 5-7** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term "inherent information" in **claim 5**, lines 11-12 and 15, is a relative term which renders the claim indefinite. The term "inherent information" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.  
"Inherent information" will be interpreted as information that naturally belongs to the apparatus such that the apparatus can perform and output all necessary operations.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1,2 and 4 are rejected under 35 U.S.C. 102(e) as being unpatentable by Kato (U.S. Patent No. 5,974,005) .**

Regarding **claims 1**, Kato discloses a voice recording and reproducing apparatus (figure 1; column 1, lines 24-35) comprising:

conversion means (analog-to-digital converter; figure 2, element 29) for converting inputted voice signal into digitized voice data (column 5, lines 8-9)  
header information storage means (head portion; figures 3, 4, 6 and 9) for storing header information (column 5, lines 29-38)

recording means (recording means; figure 1, lower element 14) for adding header information stored in said header information storage means to said voice data converted by said conversion means and for recording said voice data in voice data recording means (column 3, lines 44-56)

changing means (editing operations) for communicating with an external apparatus (CPU) and for changing header information stored in said header

information storage means (head portion) based upon information sent from the external apparatus (column 6, lines 60-67).

Regarding **claim 2**, Kato discloses that the said header information storage means is a rewritable nonvolatile storage medium (RAM; column 4, lines 34-35 and 51-53); and

said changing means rewrites header information stored in said header information storage means as header information sent from said external apparatus (column 5, lines 26-38).

Regarding **claim 4**, Kato's voice recording and reproducing apparatus can change at least one of data identifying an user, data identifying a work type, data displayed on a display portion of the voice recording and reproducing apparatus (display unit; figure 2, element 24) or data concerning the data displayed on said display portion among said header information.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3 and 5-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (U.S. Patent No. 5,974,005) in view of Kurano et al, hereinafter referenced as Kurano.

Regarding **claim 3**, Kato discloses a voice recording and reproducing apparatus but lacks having voice creation means. Kurano discloses voice file creation means (figure 15 and 35) for creating a voice file (video file) from said voice data (audio data) and said header information (column 8, lines 47-50, column 14, line 17 – column 15, line 21 and column 25, lines 31-36) in order to store and retrieve voice data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kato's invention such that it comprises voice file creation means in order to store and retrieve voice data that has been recorded in order to selectively record voice in correspondence with the recording of the prescribed data.

Regarding **claim 5**, Kato discloses and information processing apparatus (Central Processing Unit (CPU); column 4, lines 51-53) that is connectable to a voice recording and reproducing apparatus for digitizing and recording inputted voice signals in a recording medium but lacks comprising information acquisition means and control means for carrying out the acquisition. Kurano discloses information acquisition means (CPU section; figure 1, element 50) for acquiring the information of said voice recording and reproducing apparatus (column 19, lines 42-57 and column 20, lines 8-36); and control means (parental control) for carrying out controls in accordance with the information acquired by said information acquisition means so that at least one of the control program or the control data of said voice recording and

Art Unit: 2655

reproducing apparatus may be changed (column 9, lines 46-48 and column 22, lines 64-67) in order to manage disk information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kato's invention such that it acquires information, for example, recording position, display time, volume and other information related to the device so that voice (audio) data can be transmitted and allows the user to effectively use and manage disk information.

Regarding **claim 6**, Kato discloses a recording and reproducing apparatus wherein when recording inputted voice signals as digitized voice data (column 5, lines 8-9), said voice recording and reproducing apparatus adds predetermined header information to said voice data (column 5, lines 29-38); and

    said control means that carry out controls so that said header information recorded by said voice recording and reproducing apparatus may be changed (MD; figure 3, element 13; column 5, lines 26-38).

Regarding **claim 7**, Kato's voice recording and reproducing apparatus can change at least one of data identifying an user, data identifying a work type, data displayed on a display portion of the voice recording and reproducing apparatus (display unit; figure 2, element 24) or data concerning the data displayed on said display portion among said header information.

Regarding **claim 8**, Kato discloses a recording medium having recorded an information processing program (figure 5; column 2, lines 47-52) for causing a computer connectable to a voice recording and reproducing apparatus digitizing inputted voice signals (column 5, lines 8-9), but lacks comprising information

Art Unit: 2655

acquisition means and control means for carrying out the acquisition. Kurano discloses a processing program (system processor; figure 1, element 54) and recording in a recording medium (column 1, lines 11-20) to acquire the information of said voice recording and reproducing apparatus (column 19, lines 42-57 and column 20, lines 8-36); and

a processing program for changing at least one of the control program and the control data of said voice recording and reproducing apparatus according to said information (column 9, lines 46-48 and column 22, lines 64-67), in order to manage disk information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kato's invention such that it acquires information and has changing means to control information, for example, recording position, display time, volume and other information related to the device so that voice (audio) data can be transmitted and allows the user to effectively use and manage disk information.

Regarding **claim 9**, Kato discloses a recording and reproducing apparatus wherein when recording inputted voice signals as digitized voice data (column 5, lines 8-9), said voice recording and reproducing apparatus adds predetermined header information to said voice data (column 5, lines 29-38).

    said information processing program includes a processing program for causing said computer to change header information recorded by means of said voice recording and reproducing apparatus according to said information (MD; figure 3, element 13; column 5, lines 26-38).

**Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent No. 5,903,871 to Terui et al. discloses a voice recording and/or reproducing apparatus

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jakieda R Jackson whose telephone number is 703.305.5593. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Talivaldis I. Smits can be reached on 703. 306-3011. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9314 for regular communications and 703.872.9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.4700.

JRJ  
November 17, 2003



RICHEMOND DORVIL  
SUPERVISORY PATENT EXAMINER